

NIXON & VANDERHYE PC Fax:703-816-4100

** Transmit Conf. Report **

P. 1

Mar 4 2005 14:36

| Fax/Phone Number | Mode | Start | Time | Page | Result | Note |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 1931-337

C# M#

Reid W. von Borstel

TO/A.U. 1632

Serial No. 09/838,135

Examiner: Ganapathy Krishnan

Filed: April 20, 2001

Date: March 4, 2005

Title: COMPOSITIONS AND METHODS FOR TREATMENT OF MITOCHONDRIAL
DISEASESCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR SUSPENSION OF ACTION

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

 Correspondence Address Indication Form Attached.

Fees are attached as calculated below:

| | | | | | | | |
|--|---|--|----|-----------------|-------------|-----------------------------|----|
| Total effective claims after amendment | 0 | minus highest number previously paid for | 20 | (at least 20) = | 0 x \$50.00 | \$0.00 (1202)/\$0.00 (2202) | \$ |
|--|---|--|----|-----------------|-------------|-----------------------------|----|

| | | | | | | | |
|------------------------------------|---|--|---|----------------|--------------|-----------------------------|----|
| Independent claims after amendment | 0 | minus highest number previously paid for | 3 | (at least 3) = | 0 x \$200.00 | \$0.00 (1201)/\$0.00 (2201) | \$ |
|------------------------------------|---|--|---|----------------|--------------|-----------------------------|----|

If proper multiple dependent claims now added for first time, (Ignore improper); add

\$380.00 (1051)/\$180.00 (2051) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s)

| | |
|------------------------|-------------------------------------|
| One Month Extension | \$120.00 (1251)/\$60.00 (2251) |
| Two Month Extensions | \$450.00 (1252)/\$225.00 (2252) |
| Three Month Extensions | \$1020.00 (1253)/\$510.00 (2253) |
| Four Month Extensions | \$1590.00 (1254)/\$795.00 (2254) \$ |

Terminal disclaimer enclosed, add

\$180.00 (1814)/ \$85.00 (2814) \$

 Applicant claims "small entity" status. Statement filed herewith

Rule 58 Information Disclosure Statement Filing Fee \$180.00 (1808) \$

Assignment Recording Fee \$40.00 (8021) \$

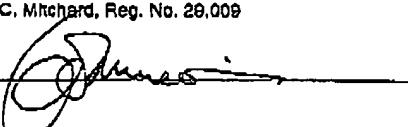
Other: Request for Suspension of Action \$

TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge the fee for the present Request to our Account No. 14-1140.

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
LCM:lrm

NIXON & VANDERHYE P.C.
By Atty: Leonard C. Mitchell, Reg. No. 28,009

Signature: 

832236

Mar 4 2005 14:39 P.02

In re Patent Application of

Atty Dkt. 1331-337
C# M#

Reid W. von Borstel

TC/A.U. 1632

Serial No. 09/838,136

Examiner: Ganapathy Krishnan

Filed: April 20, 2001

Date: March 4, 2005

Title: COMPOSITIONS AND METHODS FOR TREATMENT OF MITOCHONDRIAL
DISEASES

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

REQUEST FOR SUSPENSION OF ACTION

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Correspondence Address Indication Form Attached.

Fees are attached as calculated below:

Total effective claims after amendment 0 minus highest number
previously paid for 20 (at least 20) = 0 x \$50.00 \$0.00 (1202)/\$0.00 (2202) \$

Independent claims after amendment 0 minus highest number
previously paid for 3 (at least 3) = 0 x \$200.00 \$0.00 (1201)/\$0.00 (2201) \$

If proper multiple dependent claims now added for first time, (ignore improper); add

\$360.00 (1051)/\$180.00 (2051) \$
Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s)

One Month Extension \$120.00 (1251)/\$60.00 (2251)

Two Month Extensions \$450.00 (1252)/\$225.00 (2252)

Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)

Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

Terminal disclaimer enclosed, add

\$130.00 (1814)/ \$65.00 (2814) \$

Applicant claims "small entity" status. Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee

\$180.00 (1806) \$

Assignment Recording Fee

\$40.00 (8021) \$

Other: Request for Suspension of Action

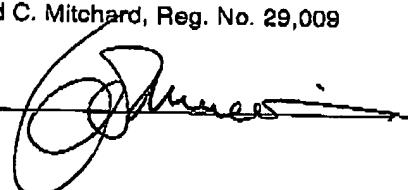
\$

TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge the fee for the present Request to our Account No. 14-1140.

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Facsimile: (703) 816-4100
LCM:lrm

NIXON & VANDERHYE P.C.
By Atty: Leonard C. Mitchard, Reg. No. 29,009

Signature: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Reid W. von Borstel Atty. Ref.: 1331-337; Confirmation No. 2922
Appl. No. 09/838,136 TC/A.U. 1632
Filed: April 20, 2001 Examiner: Ganapathy Krishnan
For: COMPOSITIONS AND METHODS FOR TREATMENT OF MITOCHONDRIAL
DISEASES

* * * * *

March 4, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR SUSPENSION OF ACTION BY THE OFFICE

Pursuant to 37 CFR 1.103(a), Applicants hereby request that the Office grant a suspension of action in this case for a period of six (6) months from the date of the present Request, expiring on September 4, 2005. The required good and sufficient cause for suspension of action is discussed below.

The undersigned has been advised by the Examiner by telephone that the present application is in condition for allowance. As of today's date, however, no paper has issued indicating that the application has been allowed. Therefore, no action is outstanding from the Office requiring a reply by the applicants (37 CFR 1.103(a)).

Inventorship of the invention as claimed in the present application is currently under dispute as between the presently named inventor Reid Von Borstel of Wellstat

Reid W. von Borstel
Appl. No. 09/838,136
March 4, 2005

Therapeutics Corporation and Robert K. Naviaux of the University of California, San Diego (UCSD). The Information Disclosure Statements filed on May 14, 2001, January 18, 2002, February 14, 2002 and May 29, 2002 have alluded to the litigation proceedings between these two parties. The matter is now destined to be arbitrated before an arbitrator. No firm date has been set for initiation of these proceedings, although they are expected to begin later in 2005, once the parties have settled on an arbitrator.

The good and sufficient cause for suspension of action is based on the fact that one possible outcome of the forthcoming arbitration is a change of inventorship and therefore ownership as well. A change of inventorship and/or ownership could raise new issues of patentability, for example potential obviousness-type double patenting with one or more patent applications filed by UCSD. Moreover, in the event that a change in inventorship or ownership is indicated, it would be more expeditious for the parties to prepare and file any necessary change of inventorship and assignment documentation while the case is pending and prior to allowance, rather than after allowance or after grant. For the above reasons, it is believed that good and sufficient cause is present for suspension of action in this case.

The present Request has been transmitted to the USPTO by facsimile transmission (571-273-8300) on March 4, 2005. At the suggestion of the Examiner's supervisor (James O. Wilson), a copy of the present paper (together with a copy of the facsimile confirmation page evidencing transmission today to 571-273-8300) is also being forwarded by facsimile transmission to the Examiner (571-273-0654).

NIXON & VANDERHYE PC Fax:703-816-4100

Mar 4 2005 14:40 P.05

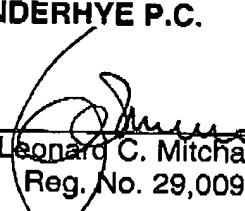
Reid W. von Borstel
Appl. No. 09/838,136
March 4, 2005

The Commissioner is authorized to charge the fee for this Request to our deposit account No. 14-1140.

Favorable action on this Request is awaited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Leonard C. Mitchard
Reg. No. 29,009

LCM:lfm
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Arlington, VA 22201-4714
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